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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,611	12/08/2000	Wahcguru Pal Singh	LYNN/0120	4196

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/733,611	SINGH ET AL.	
	Examiner	Art Unit	
	Sabiha Naim Qazi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on 07 October 2002.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) 1-11, 17 and 26-51 is/are pending in the application.

4a) Of the above claim(s) 26-51 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) 1-11 and 17 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) 26-51 are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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Final Action on Merits

New claims 26-51 are added, 1-11, 17 and 26-51 are pending. Claims 1-11 and 17 are rejected, others are withdrawn from consideration as non elected invention. Newly submitted claims 26-51 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 26-29, 30-51 are drawn to method of preparing a sterilizing solution which are different from originally claimed invention. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. These claims would require a burdensome bibliographic, manual and database search. Accordingly, claims 26-51 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

No claim is allowed.

Amendments and response filed in paper no. 10 is hereby acknowledged. Amendments are entered. All the rejections are maintained for the same reasons as set forth in our previous office action because arguments are not found persuasive.

Argument on prior art teaching that "percarboxylic acids may be used in combination with hydrogen peroxide to form a composition for controlling microbial growth, Lokkesmoe does not teach or suggest that dicarboxylic acid alone is an effective composition for use as sterilizing agent when dissolved in water", (see last three lines on page 9 of the response) was considered. Note, that present claims contain the term "comprising" which allows further ingredients to be added. Furthermore, Applicant's own specification discloses that "The term "comprising" means that the recited elements or steps may be only part of the device and does not exclude additional unrecited elements steps", see lines 7 and 8 on page 13 of specification. See also last paragraph on page 13 where applicant disclose, "It will be understood that certain combinations and sub-combinations of the invention are of utility and may be employed without reference to other features in sub combinations".

Since other elements and steps are allowed in the present claims, therefore prior art teachings can be applied to achieve the instantly claimed invention. For the same reasons presently claimed invention would have been obvious to one skilled in the art at the time of invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1-11 and 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "comprising" cited in claims is inclusive and fails to exclude unrecited steps. The use of the term comprising to introduce claimed structure means that the ingredients covered by these claims may involve more elements than those positively recited. *Ex parte Gottzein et al.*, 168 USPQ 176 (PTO Bd. App. 1969). Comprising leaves the claim open for inclusion of unspecified ingredients even in major amounts. *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lokkesmoe et al. (US Patent 5,674,538) and Huber, Arthur Elmer (US Patent 4,013,581). Lokkesmoe teaches a method of controlling microbial growth in aqueous stream by using percarboxylic acid, which embraces applicant's claimed invention. See the entire documents especially lines 34-67, col. 4; lines 18-67, col. 6; examples and claims of the US '538; lines 5-50 and lines 64-68, col. 2; lines 5-17 and lines 54-59, col. 3; lines 48-68, col. 5; lines 1-19, col. 6; see examples 1 and 3 and claims of US 4,013,581. Huber teaches a bleach tablet composition containing solid dipercarboxylic acid such as diperazelaic acid, which is a dipercarboxylic acid and specifically claimed in instant claim 7.

3. Instant claims are drawn to sterilizing solution, which comprises storing dry solid comprising one or more dicarboxylic acid, and then dissolving said solid carboxylic acid into water. Instant claims differ from the reference in dissolving a solid acid in water.

It would have been obvious to one skilled in the art to be motivated at the time of invention to prepare additional beneficial antimicrobial composition especially when prior art teaches the antimicrobial formulation using a solid dipercarboxylic acid. Motivation is that prior art teaches solid peroxydicarboxylic acid such as Diperazelaic acid for preparing tablets where diperoxyacids are satisfactorily stabilized with sodium sulfate. The method as claimed would have been obvious in view of teachings of the prior art.

After solution is prepared the activity of the solution is expected to be the same, no matter how it is prepared. Therefore, in absence of any criticality or unexpected results instant invention is considered obvious.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Naim Qazi whose telephone number is 703-305-3910. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

December 22, 2002


SABIHA QAZI, PH.D
PRIMARY EXAMINER